THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte WESLEY C. FORT

Appeal No. 96-3164
Application 08/322,034[1]

ON BRIEF

Before CALVERT, COHEN and MEISTER, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 13, all the claims in the application. Claim 12 has since

[1] Application for patent filed October 12, 1994. According to appellant, this application is a continuation of Application 08/128,872, filed September 29, 1993, now abandoned.

been cancelled, leaving claims 1 to 11 and 13 for our consideration.[2]

The independent claims on appeal, claims 1, 9 and 13, are reproduced in the appendix hereto.

The references upon which the final rejection is based are:

Cocks et al. (Cocks)	4,488,665	Dec. 18, 1984
Ziecker et al. (Ziecker)	4,785,996	Nov. 22, 1988
Miller et al. (Miller)	4,983,109	Jan. 8, 1991

Claims 1 to 11 and 13 stand finally rejected under 35 U.S.C. § 103 on both of the following grounds:

(1) Unpatentable over Cocks;

(2) Unpatentable over Miller in view of Ziecker.

Rejection Under 37 CFR § 1.196(b)

Before considering the rejections under 35 U.S.C. § 103, we make the following rejection pursuant to 37 CFR § 1.196(b): Claim 13 is rejected for failing to comply with the second paragraph of 35 U.S.C. § 112. The claim is indefinite in that

[2] An amendment filed after the final rejection (Paper No. 8, filed January 17, 1995) was initially not entered by the examiner, but in the answer (page 2) the examiner states that it has been entered to the extent that it cancels claim 12, and as a result, the rejection of claims 12 and 13 under 35 U.S.C. § 112, second paragraph, is withdrawn.

the antecedent of "said adhesive passageways" (lines 11-12) and "said passageways" (line 14) is not clear. This claim previously recites two different pluralities of adhesive passageways, one being the "series of adhesive passageways" in the manifold (lines 3-4), and the other being the adhesive passageways included in the plurality of nozzles (lines 5-6). Accordingly, the bounds of the claimed subject matter are not distinct,[3] because "said adhesive passageways" and "said passageways" are not further limited and therefore it cannot be determined which of the two previously-recited pluralities of passageways they are intended to cover.

While a claim which is indefinite normally should not be rejected on prior art, In re Steele, 305 F.2d 859, 862-63, 134 USPQ 292, 295 (CCPA 1962), we will, in the interest of avoiding piecemeal appellate review, interpret claim 13 as if it specified that the "passageways" in lines 12 and 14 were the passageways in the adhesive manifold. Cf. Ex parte Ionescu, 222 USPQ 537, 540

[3] See In re Merat, 519 F.2d 1390, 1396, 186 USPQ 471, 476 (CCPA 1975).

(Bd. App. 1984). Our consideration below of the rejection of claim 13 under 35 U.S.C. § 103 is based on this interpretation.

Rejections Under 35 U.S.C. § 103

It is unnecessary to reproduce the basis of these rejections, or the entirety of the appellant's and examiner's arguments. With regard to each rejection, the examiner recognizes that the stems of needle valves 31 of Cocks or 22 of Ziecker do not extend into the adhesive manifold or have valve seats located in the adhesive passageways of the adhesive manifold, as called for by the claims on appeal.[4] Nevertheless, the examiner takes the position that it would have been obvious to relocate the needle valves to the manifold, stating (answer, page 3):

> [T]he rearrangement of location of parts to [sic: of] an apparatus is considered obvious and within the purview of one of ordinary skill in the art (see In re Japikse, [181 F.2d 1019,] 86 USPQ 70 [(CCPA 1950)]).

In response to appellant's argument that there is no motivation in the prior art to relocate the valves of the references, the

[4] Claim 13 does not recite that the valve stems extend into the adhesive manifold, but (as interpreted) does require valve seats located in the adhesive passageways of the manifold.

examiner states that "the motivation for such reposition is founded in the cited precedent decision [(Japikse)]" (answer, page 7).

The following quotation from page 6 of appellant's brief[5] concisely sets forth the requirements for a conclusion of obviousness under § 103:

> Under the present standard for obviousness, to reach the conclusion that the claimed invention would have been obvious, case law now clearly requires that there must have been some teaching or suggestion in the prior art or knowledge generally available to one of ordinary skill in the relevant art which would have led one of ordinary skill to the invention. ACS Hospital Systems, Inc. v. Montefiore Hospital et al., 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984); W. L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); In re Sernaker, 702 F.2d 989, 217 USPQ 1 (Fed. Cir. 1983)[, cert. denied, 469 U.S. 851 (1984)]. That motivation, suggestion or knowledge cannot come from applicant's invention itself. In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

In the present case, the examiner does not point to any suggestion or motivation in the references, or even offer any other motivation for relocating the valves of the references,

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[5] All references herein to the brief are to the corrected brief filed September 8, 1995 (Paper No. 21).

other than to refer to the Japikse case, which itself contains no such motivation. In fact, the examiner's position might be characterized as being, in effect, that there is a "rule" that the repositioning or relocation of parts of a known apparatus would be, per se, prima facie obvious under § 103.

Our reviewing courts have, however, cautioned against the automatic application of such "rules." For example, in In re Wright, 343 F.2d 761, 145 USPQ 182 (CCPA 1965), the court, in affirming a rejection under § 103, stated (343 F.2d at 769-70, 145 USPQ at 190,) (original emphasis):

> We agree with the solicitor that "the elimination of the temperature parameter for the afterburner fuel control of Chandler * * * together with its tailpipe safeguarding function, would be an obvious expedient," but we hasten to add that this finding is based upon a *determination of obviousness under section 103* and not upon a mechanical rule, which the solicitor would have us extract from In re Karlson, 50 CCPA 908, 311 F.2d 581, 136 USPQ 184 [(1963)], about the omission of an element and its function from a known combination being obvious if the remaining elements perform the same function as before. Language to this effect in Karlson was never intended to short-circuit the clear wording of 35 U.S.C. [§] 103.

Thus, the requisite motivation cannot merely be, in the examiner's words, "founded in the cited precedent decision."

Absent some reason as to why one of ordinary skill would have found it obvious in view of the prior art to modify the structure disclosed in the references to arrive at the subject matter defined in the claims on appeal, and we find none, the rejection appears to be based on impermissible hindsight derived from appellant's own disclosure, and cannot be sustained.[6]

Conclusion

The examiner's decision to reject claims 1 to 11 and 13 under 35 U.S.C. § 103 is reversed. Claim 13 is rejected under 35 U.S.C. § 112, second paragraph, pursuant to 37 CFR § 1.196(b).

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date of the decision. 37 CFR § 1.197. Should appellant elect to have further prosecution before the examiner in response to the new

[6] Ironically, another issue in the Karlson case cited by the court in Wright, supra, was the obviousness of a change in location of an element of the prior art apparatus. The court affirmed the Board's holding that the relocation was "of no patentable significance," but in so doing stated reasons for its holding, as well as noting that such relocation was disclosed in the prior art (311 F.2d at 584, 136 USPQ at 186).

rejection under 37 CFR § 1.196(b) by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire two months from the date of this decision.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED - 37 CFR § 1.196(b)

IAN A. CALVERT)
Administrative Patent Judge)
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)
)
IRWIN CHARLES COHEN) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
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APPENDIX

1. Apparatus for dispensing hot melt adhesive comprising:

an adhesive manifold including an adhesive input port for supplying adhesive to a series of adhesive passageways in said adhesive manifold;

a plurality of nozzles attached to said adhesive manifold, each nozzle including an adhesive passageway communicating with the adhesive passageways of said adhesive manifold; and,

a plurality of needle valves extending into said adhesive manifold, each needle valve including a valve stem extending into said adhesive manifold and including a portion thereof which is adjustable relative to a valve seat located in the adhesive passageways of said adhesive manifold for controlling the flow of adhesive to a nozzle.

9. A method of continuously applying a coating of hot melt adhesive on a substrate with an adhesive dispensing applicator

including an adhesive control valve connected to a manifold having a plurality of adhesive passageways connected to a plurality of generally aligned dispensing nozzles by way of a plurality of needle valves which respectively control the flow of adhesive to said plurality of dispensing nozzles, each needle valve including a valve stem extending into said manifold and including a portion thereof which is adjustable relative to a valve seat located in the adhesive passageways of said manifold for controlling the flow of adhesive to a nozzle, the method comprising the steps of:

opening said control valve to allow molten adhesive to flow into said fluid paths,

adjusting said needle valves to establish a predetermined flow rate of adhesive through each respective nozzle and a resulting predetermined adhesive coating pattern on said substrate, and

moving said substrate and said dispensing applicator with respect to each other while said control valve is opened so as to coat said substrate with adhesive discharged from said nozzles.

13. Apparatus for dispensing hot melt adhesive comprising:

an adhesive manifold including an adhesive input port for supplying adhesive to a series of adhesive passageways in said adhesive manifold;

a plurality of nozzles attached to said adhesive manifold, each nozzle including an adhesive passageway communicating with the adhesive passageways of said adhesive manifold; and,

a plurality of needle valves connected to said adhesive manifold and including valve stems which are adjustable relative to valve seats located in said adhesive passageways, said valve stems being operatively connected to respective manually operable handles for allowing adjustment in the flow rate of adhesive within said passageways.